

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD RASHMAN

Appeal No. 2000-0798
Application No. 08/410,852

ON BRIEF

Before CALVERT, ABRAMS, and STAAB, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 13, all the claims remaining in the application.

The claims on appeal are drawn to an autoclavable medical instrument (claims 1 to 6) and a method of making a medical instrument (claims 7 to 13). The examiner states (answer, page 3) that claims 1 and 7 are erroneously presented in the appendix (Appendix A) of appellant's brief, and are correctly

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written in an appendix to the examiner's answer, but since no such appendix to the answer is found, claims 1 and 7 (the only independent claims on appeal) are reproduced as follows:¹

1. An autoclavable medical instrument comprising:
a metallic shaft having an end; and
a colored synthetic handle molded to encase the end of the metallic shaft wherein the color of the synthetic handle identifies the instrument as belonging to a predetermined group.

7. A method of making a medical instrument readily identifiable comprising the steps of
producing a metal portion of the instrument having a shaft; and
encapsulating an end of the shaft in a colored autoclavable synthetic material such that the encapsulating synthetic material identifies the medical instrument as belonging to a predetermined group.

The references applied in the final rejection² are:

Hamas	4,671,916	Jun. 9,
1987		
Bedner et al. (Bedner)	4,798,000	Jan. 17,
1989		

¹ These claims are as amended by the amendment filed on Sept. 29, 1997.

² Paper No. 24, Dec. 4, 1998, the third final rejection in the case.

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Additional references applied herein in a rejection pursuant
to 37 CFR § 1.196(b) are:³

Rubricuis	3,740,779	Jun.
26, 1973		
Eaton et al. (Eaton)	3,750,282	Aug. 7,
1973		
Linden	4,882,867	Nov. 28,
1989		

Claims 1 to 13 stand finally rejected under 35 U.S.C. §
103(a) as unpatentable over Hamas in view of Bedner.

After fully considering the record in light of the
arguments presented in the appellant's brief and reply brief,
and in the examiner's answer, we conclude that the appealed
claims are patentable over the combination of references
applied in the final rejection.

On page 5 of the answer, the examiner explains the basis
for the rejection as:

It is felt that one of ordinary skill would
be aware of techniques for forming both metal
and plastic implements. Bedner notes tha both
metal and plastic may be molded for use as
handles. He states that metal is preferred due

³ The Eaton and Linden patents are already of record in
the application. A copy of Rubricuis is enclosed herewith.

to its weight and rigidity. He also states that molding a handle is relatively inexpensive.

With this information in mind one of ordinary skill would consider improving Hamas. Hamas states that while plastic plugs of various colors and shapes are useful for identification of instruments coloring the entire handle might be more desirable if it were not more expensive. The solution would appear to be obvious. Rather than drilling holes and inserting plastic plugs merely mold plastic around the handle. Thus a better and cheaper instrument is produced since the weight and rigidity of metal is retained and the entire handle colored by an inexpensive process.

We do not agree with the examiner's reasoning. Claim 1 requires that the synthetic handle be "molded to encase the end of the metallic shaft," and claim 7, "encapsulating an end of the shaft in a colored autoclavable synthetic material." The examiner does not identify where in the Hamas patent it is disclosed that "coloring the entire handle might be more desirable [than plastic plugs] if it were not more expensive"; presumably, this refers to Hamas' disclosure at col. 3, lines 17 to 19, that using plastic plugs "is less costly than painting the stainless steel handles of each instrument." In any event, we find no disclosure in either Hamas or Bedner of molding or encapsulating the end of the instrument shaft, as claimed. The examiner states on page 2 of the final rejection

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that "Bedner shows a molded handle encasing the shank of an autoclavable knife," but we find no such disclosure in Bedner; rather, this reference discloses a handle which is all metal (col. 1, line 14) or, arguably, all plastic (col. 1, lines 6 and 7) and which holds a detachable surgical blade 40 at one end. Absent any teaching or suggestion in the prior art of molding or encapsulating the end of the instrument shaft, the examiner's conclusion that it would have been obvious to "merely mold plastic around the handle" appears to be based on improper hindsight gleaned from appellant's own disclosure. It follows that a prima facie case of obviousness has not been established.

The rejection of claims 1 to 13 therefore will not be sustained.

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Rejection Pursuant to 37 CFR § 1.196(b)

Pursuant to 37 CFR § 1.196(b), claims 1 to 5 and 7 to 12 are rejected under 35 U.S.C. § 103(a) as unpatentable over Rubricuis in view of Eaton or Linden, taken with Hamas.

Rubricuis discloses a medical instrument comprising a metal scalpel blade 1 attached to a handle 2 which is made of polypropylene (col. 4, line 14) and is colored so that different size scalpel blades can be easily identified (col. 2, lines 44 and 49). Rubricuis does not specifically disclose that the instrument should be autoclavable, but it would have been obvious to make the handle out of autoclavable plastic in view of Rubricius' disclosure that it can be "presterilized", and the teaching of Hamas that plastic used in surgical instruments should be autoclavable (col. 2, lines 46 to 52).

Claim 1 calls for the handle to be molded to encase the end of the metallic shaft, and claim 7, for encapsulating an end of the shaft in synthetic material. Rubricuis discloses that scalpel blade 1 is attached to the handle 4 by "snap clamp 2 or other suitable means" (col. 2, lines 11 to 13). Both Eaton and Linden disclose medical instruments in which a

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plastic handle (Eaton 16, Linden 1) is attached to the
metallic portion (blades 18 of Eaton, tools 2, 3 of Linden) by
molding the handle would the metallic portion (Eaton, col. 2,
lines 50 to 54; Linden,

Fig. 4 and col. 2, line 60, to col. 3, line 2). In view of either of Eaton or linden, it would have been obvious to employ molding as the "other suitable means" referred to by Rubricuis at col. 2, line 13, for attaching the metal scalpal blade 1 to plastic handle 4, noting that Rubricuis states at col. 2, lines 38 and 39, tht plastic can be "easily injection molded." The use of molding to attach Rubricuis' handle 4 to the end of blade 1 would have been the obvious selection of a known attachment method, and would have been particularly suggested to one of ordinary skill in the art by Eaton's disclosure that such a method of attachment is strong, rigid and inexpensive (col. 4, lines 36 to 40).

With regard to claims 2 and 9, the handle of the Rubricuis scalpel, beings polypropylene, would inherently be nondegradable in body fluids, as appellant discloses at page 6, lines 25 and 26 of the specification.

As for claims 4 and 11, one of ordinary skill would obviously select a polypropylene for the handle of the Rubricuis device which would resist the autoclave temperatures; seee Hamas's disclosure at col. 5, last two paragraphs, of the desirability of using plastics having a UL

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temperature index of around 120EC. (248EF) or higher, most preferably of a material which can be heated to 250EC. (482EF.).

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The recitation in claims 5 and 10 of a handle which is nonporous and defines substantially no interstices with the shaft would appear to be the inherent result of the molding process, and in any event these would obviously be desirable characteristics of a medical device.

Conclusion

The examiner's decision to reject claims 1 to 13 is reversed. Claims 1 to 5 and 7 to 12 are rejected pursuant to 37 CFR § 1.196(b).

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b)

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	

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LAWRENCE J. STAAB)
Administrative Patent Judge)

SLD

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REVERSED

Prepared: June 28, 2001